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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,628	06/26/2006	Naoyuki Onoda	10993.0272	9660
22852	7590	06/10/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ROBINSON, CHANCEITY N	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			06/10/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/584,628

**Applicant(s)**

ONODA ET AL.

**Examiner**

CHANCEITY N. ROBINSON

**Art Unit**

1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/20/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date 03/25/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/20/2010 has been entered.
2. Claims 1-12 and 14-19 are currently pending. Claims 10-12 and 14-16 have been withdrawn.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-9 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language, "selected from" recited in independent claim 1 and dependent claims 3 is improper Markush claim language. The claim language should recite "selected from the group consisting of" in claims 1 and 3. Correction is required.
5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "a binder polymer comprising a polar group-containing polymer and a hydrophobic polymer...". Examiner notes since the binder polymer is comprised of two different polymers, then the binder should be called a copolymer. Appropriate correction

is required. For purposes of examination, the examiner has considered the binder polymer in claim 2 to be a copolymer.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "wherein the photopolymer comprises..."; however, there is no photopolymer in claim 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 3-9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji (US 2002/0182543 A1) in view of Wallbillich (US 4,876,118).

Fuji discloses a method (abstract) for producing a water-developable photopolymer plate for letterpress printing plate [0001] comprising an exposure step [0009 and 0076], a development step [0012, 0046-0047 and 0060-0062] and post-exposure step [0072 and 0081]. The method further comprises a contact step during or after the exposure step and irradiation step with actinic light during or after the contact step [0009, 0018 and examples 1 and 2].

Fuji does not explicitly disclose that the contact step brings the photopolymer plate into contact with a liquid comprising a silicone compound and/or fluorine compound modified with a reactive functional group. Fuji discloses the contact step includes spraying the developing liquid on the photopolymer plate [0009 and examples]. The developing liquid containing a silicone mixture [0076] or an aqueous developing liquid comprises of water, surfactant, organic carbonyl compound, hydrogen abstracting agent and other components that do not impair the effect of the invention [0045-0059]. The purpose of Fuji is the development of a method for developing a photosensitive letterpress plate that reduces the cost to treat worn out developing liquid and to give sharp printing results [0008-0009].

However, Wallbillich disclose a gravure printing plate (column 1, lines 5-11) that is contacted with a liquid comprising a silicone compound modified with one or more reactive functional groups (column 3, lines 36-51) and/or fluorine compound that is a compound in which the hydrogen atoms of a hydrocarbon compound are partially or completely substituted with fluorine atoms (column 2, line 59- column 3, line 34). Examiner notes that Wallbillich and Fuji are analogous art in printing plate technology.

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to include/modify the developing solution of Fuji to comprise a silicone compound

modified with one or more reactive functional groups and/or fluorine compound that is a compound in which the hydrogen atoms of a hydrocarbon compound are partially or completely substituted with fluorine atoms as disclosed by Wallbillich in view aiding in eliminating damages to the printing plate and undesirable impression.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-12 and 14-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHANCEITY N. ROBINSON whose telephone number is (571)270-3786. The examiner can normally be reached on Monday to Friday (with every other Friday off): 9:00 am-6:00 pm eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chanceity N. Robinson/  
Examiner, Art Unit 1795

/Cynthia H Kelly/  
Supervisory Patent Examiner, Art Unit 1795